

REMARKS

Claims 21-43 were examined in the Office Action mailed October 10, 2008.

The following objection and rejections are currently pending:

- Objections to the drawings for failing to illustrate the two electric motors recited in claim 1, and for the presence of German words in the drawings.
- Rejection of claims 21-43 under 35 U.S.C. § 112, first paragraph, as not enabled, on the ground that it is not clear what and where the caliper joint is in the figures.
- Rejection of claims 21-43 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative 35 U.S.C. § 103(a) as unpatentable over, International Patent Publication No. WO 02/14125 ("WO '125").

The following remarks are respectfully submitted to address each of these issues.

1. **A Two-Motor Embodiment Is Illustrated In Fig. 7.** The Applicants respectfully draw the Examiner's attention to elements 19 and 35 in Fig. 7, which are identified in Substitute Specification ¶ [0043] as two electric motors. Accordingly, reconsideration and withdrawal of this drawing rejection is respectfully requested.

As to the remaining drawing objection, the Applicants are submitting herewith Replacement Sheets for Figs. 2-4 which delete the objected-to German words. Examiner approval of the proposed changes to Figs. 2-4 is respectfully requested.

2. **The Section 112, First Paragraph Rejection.** The Applicants respectfully request withdrawal of the § 112, first paragraph, rejection on the ground that the recited caliper joint is illustrated and described in a manner readily understood by one of ordinary skill in the art.

Claim 21 recites that the adjusting devices are jointly driven on both sides of the brake disc by a single electric motor or two electric motors “arranged on an application side of a caliper joint, *said caliper joint being located between an application side and a reaction side of the caliper.*” As shown, for example in Figs. 1 and 7, these caliper embodiments are two-part calipers, with bolts 4 clamping the brake application side and reaction side of the caliper to one another. *See also* Specification ¶ [0020] (“... caliper 2 ... is in two parts here ... [t]he caliper parts 2a and 2b are screwed to one another by means of studs 4”). In this context, one of ordinary skill in the art would readily understand that the “caliper joint” is the line along which the two sides of the caliper meet (*e.g.*, unmarked joint line being visible between the two sides in both Fig. 1 and Fig. 7). Accordingly, the Applicants submit that claims 21-43 are sufficiently enabled for the purposes of § 112, first paragraph, and respectfully request reconsideration and withdrawal of the pending § 112 rejection.

In view of the foregoing, reconsideration and withdrawal of the pending § 103(a) rejection based on the combination of the Breed and Haun references is respectfully requested.

3. The Claims Are Patentable Over the WO ‘125 Reference. The Applicants respectfully traverse the rejection of claims 21-43 as anticipated, or obvious in view of, the WO ‘125 reference (which the Applicants themselves identified and distinguished in their original disclosure beginning at ¶ [0003]) on the ground that this reference does not disclose or suggest all of the features of the present invention for which it is cited.

In the pending Office Action, WO '125 Figs. 3 and 25 are identified as disclosing the claimed invention, and in particular showing the claimed use of two adjusting motors (citing motors 106 in Fig. 25). October 10, 2008 Office Action at 4-5.

Present claim 21 recites, *inter alia*, that “the adjusting devices are jointly driven on both sides of the brake disc by a single electric motor or two electric motors *arranged on an application side of a caliper joint*, said caliper joint being located between an application side and a reaction side of the caliper.”

Figs. 3 and 25 of the WO '125 reference do not disclose or suggest the claimed arrangement. Fig. 3 in fact does not show any electric motors, because its adjustment mechanism is driven by the mechanical motion of the brake actuator lever during brake application. As described in the paragraph at page 15, lines 22-28 of the WO '125 reference, motion of rotary lever 19 in the brake application direction drives element 82, which in turn cogwheels 52 to drive the adjusting mechanism's two transmissions¹ located at the center of each side of the caliper.

For its part, WO '125 Fig. 25 shows exactly the sort of prior art construction that the present invention improves upon, in which there are separate, space-consuming electric motors located on *both* sides of the caliper joint, leaving the electric motor on the reaction side of the brake close to the brake disk (*i.e.*, subject to very high temperatures) and enlarging the reaction

¹ The Applicants believe these transmissions may have been mistaken for electric motors, which they are not.

side of the caliper in a region inside the wheel envelope where space and wheel clearance is at an absolute premium. Thus, Fig. 25 does not disclose or suggest the claimed caliper in which: (i) "the adjusting devices are *jointly* driven on both sides of the brake disc by *a single* electric motor" – Fig. 25 showing two electric motors, *i.e.*, a single electric motor is not *jointly* driving the adjusting devices (the adjusting devices defined in the claims as devices on both sides of the brake); nor (ii) driving adjusting devices with "two electric motors *arranged on an application side of a caliper joint*, said caliper joint being located between an application side and a reaction side of the caliper – Fig. 25 showing only one of the two electric motors on the application side of the caliper.

In view of the foregoing, the Applicants respectfully submit that the WO '125 reference fails to disclose or suggest all of the features of the present invention recited in the pending claims. Accordingly, reconsideration and withdrawal of the pending § 102(b)/§ 103(a) rejection is respectfully requested.

CONCLUSION

The Applicants submit that claims 21-43 are in condition for allowance. Early and favorable consideration and issuance of a Notice of Allowance for these claims is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

please charge any deficiency in fees or credit any overpayments to Deposit
Account No. 05-1323 (Docket # 037068.56495US).

Respectfully submitted,

November 21, 2008



Jeffrey D. Sanok
Registration No. 32,169
Mark H. Neblett
Registration No. 42,028

CROWELL & MORING, LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844